

**Remarks**Application Status and Disposition of Claims

This paper responds to the final Office Action mailed April 2, 2010.

In the Action, the Office considered claims 1-12 and 33, with claims 13-32 having been withdrawn from consideration as directed to a nonelected invention.

The present amendment does not add, cancel, or amend any claims. Thus, claims 1-12 and 33 remain pending and under consideration.

Information Disclosure Statement

The Action has confirmed consideration of the Information Disclosure Statement filed on January 13, 2010, and returned, with the Official Action, signed and initialed copies of the Forms PTO-1449 that accompanied the IDS. However, the Action claims that the IDS fails to comply with 37 C.F.R. § 1.98(a)(3) because the IDS did not indicate the relevance of EP 0771589 and because EP 0771589 was not in English.

In response, Applicants note that 37 C.F.R. § 1.98 provides that: (a) any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section. Section (a)(1) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include: (i) The application number of the application in which the information disclosure statement is being submitted; (ii) A column that provides a space, next to each document to be considered, for the Examiner's initials; and (iii) A heading that clearly indicates that the list is an information disclosure statement.

Section (a)(2) requires a legible copy of: (i) each foreign patent; (ii) each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office; (iii) for each cited pending unpublished U.S. application, the application specification including the claims, and any

drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and (iv) all other information or that portion which caused it to be listed.

Section (a)(3) requires (i) a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from Applicant's specification or incorporated therein.

MPEP 609.04(a) states that “[t]he concise explanation may be either separate from the specification or part of the specification. If the concise explanation is part of the specification, the IDS listing should include the page(s) or line(s) numbers where the concise explanation is located in the specification.” It further states that “[t]he requirement for a concise explanation of relevance is limited to information that is not in the English language . . . Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an ‘X’, ‘Y’, or ‘A’ indication on a search report.”

Applicants note that the IDS indicated that EP 0771589 (Document F) was family member of U.S. Patent No. 5919566 (Document C). The IDS also provided the Supplementary European Search Report, which indicated the relevance of EP 0771589.

Accordingly, the IDS was compliant and the Office is required to indicate its consideration of all documents cited therein.

Claim Rejections – 35 U.S.C. § 102

The Office Action rejects claims 1, 2, 3, 6, and 33 under 35 U.S.C. § 102(b) as allegedly anticipated by JP 2002-309016 to Honma et al. Applicants had argued that Honma et al. fails to disclose, at least, an open-cell structure having internally formed pores. In response, the Action states that “[b]ased on the disclosure of Honma et al., the examiner finds that the membrane has internally-formed pores.” (Office Action, page 5, 4<sup>th</sup> full paragraph.) The Action argues that support is found in paragraph [0185] of Honma et al., which allegedly shows that the membrane is permeable (Id.), and in paragraph [0197], which allegedly shows that when a coating is applied to the membrane, it penetrates (Id.).

In response to the rejection, Applicants maintain their position that Honma et al. fails to disclose the presently claimed open-cell structure having internally formed pores. In particular, Applicants respectfully submit that the Office is mistaken about the disclosure of Honma et al. Applicants note that the Office’s interpretation of Honma et al. is critical to maintaining not only the rejection under 35 U.S.C. § 102, but also the rejection under 35 U.S.C. § 103 (discussed below), which relies on Honma et al. Thus, Honma et al.’s support of the Office’s inherency argument is particularly important to maintaining the rejection.

Applicants note that a copy of the translation of Honma et al. was not ever provided to Applicants, but that a copy was obtained from the electronic (PAIR) records at the USPTO for this matter. The PAIR records indicate that “Honma et al.” is a 14-page machine English-language translation of JP 2002-309016, associated with the non-final Office Action mailed September 28, 2009. Upon review of the document, Applicants found that it only includes numbered paragraphs up to [0059].

Finding that the Office Action’s arguments for inherency find support in paragraphs [0185] and [0197] of Honma et al., Applicants attempted to determine if the electronic copy in the PTO records was possibly truncated, and that the Examiner was relying on passages not in the version in the PTO’s records. Applicants therefore had a full translation of the document prepared (which is attached hereto). Indeed, it appears

that the machine English-language translation in the PTO records is truncated. However, the full translation only extends to paragraph [099].

Thus, it is unclear what passages from Honma et al. the Office believes support the rejection, because paragraphs [0185] and [0197] do not appear to exist in this document. Assuming that the Office inadvertently referred to the wrong paragraphs in Honma et al., Applicants have performed a word search for “permeable,” “permeates,” and “penetrates,” which the Action asserts that Honma et al. suggests. However, none of these words was found in the document.

Not only were these words not found in the document, “open cell,” “pore,” and “porosity,” were also not found in Honma et al. On the other hand, those words are used throughout the present specification.

According to MPEP 2112, the express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. “The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995). Further, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Finally, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Applicants respectfully submit that not only is the Office clearly mistaken in its assertion that Honma et al. discloses that its membrane is permeable, or that coating penetrates the membrane, it has failed entirely to set forth any reasonable basis for concluding that the missing features would *necessarily* be present. Indeed, Applicants

respectfully submit that the Office will not be able to establish a rejection based on inherency, *because the presently claimed membrane is not disclosed in Honma et al.* A careful comparison of the present claims and specification to Honma et al. will lead to the conclusion that the structures are different, and that Applicants' presently claimed structure is not disclosed.

Finally, Applicants note that upon further review of the record, it appears that the reference to paragraphs [0185] and [0197] may be from U.S. Application Publication No. 2003/0003340, to Honma et al. However, Applicants note that if this is true, then the rejection is improper for this reason as well. The Office has not cited this Honma et al. publication in the rejection, and the Office has failed to explain how the disclosure of this publication is related to the disclosure in JP 2002-309016 to Honma et al. Applicants submit that if the Office wishes to rely on the U.S. application to Honma et al. as supporting its inherency rejection over the Japanese publication to Honma et al., then the Office bears the burden of establishing the connection between the two publications. Accordingly, Applicants respectfully request withdrawal of the rejection for this reason as well.

In view of the foregoing, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of anticipation. Accordingly, the rejection is improper and must be withdrawn.

Claim Rejections – 35 U.S.C. § 103

The Office rejects claims 4, 5, and 7-12 under 35 U.S.C. § 103(a) as being obvious over Honma et al. in view of U.S. Patent Application Publication No. 2004/0197613 to Curiel et al. The Office concedes that Honma et al. does not disclose the additional elements claimed in claims 4 and 5, further specifying the porosity and the size of the pores in the present claims. The Office also concedes that Honma et al. does not disclose the amount of crosslinkage as claimed in claims 7 and 8. In order to cure this deficiency, the Office asserts that one of ordinary skill would be motivated to optimize the porosity and the amount of crosslinkage. Moreover, the Office concedes that Honma et al. fails to disclose the claimed formula of claims 9-12. In order to cure this deficiency,

the Office relies on Curlier et al., asserting that the silicon-containing acid group allegedly taught by Curlier et al. attached to the cross-linked material of Honma et al. would result in the structure of claim 12. Applicants respectfully disagree with the rejections for the reasons that follow.

As explained above with regard to the anticipation rejection, Honma et al. fails to disclose the features of claim 1, upon which claims 4, 5, and 7-12 depend. Applicants further note that the Office Action has failed to provide any reasonable basis for concluding that the elements missing from claim 1 would be present in the combination of Honma et al. and Curlier et al. For at least this reason, the rejection is facially deficient and should be withdrawn.

Additionally, because Honma et al. does not discuss porosity or pores at all, there can be no reasonable basis for one of ordinary skill to recognize that this property is one that can or should be “optimized.” Even assuming, for the sake of argument, that one of ordinary skill would recognize that Honma et al. discloses a structure having pores, the Office has the burden of showing that porosity is a result-effective variable and that varying it in a particular way would somehow produce a desirable effect. In the absence of such an explanation, there can be no *prima facie* case of obviousness.

Likewise with regard to the aspect of crosslinkage, the Office has the burden to explain that in the absence of explicit teaching from the cited documents, why would one of ordinary skill modify the crosslinkage of the cited documents and arrive at the particular range claimed by numerical formula (II) of claim 7. In the absence of such an explanation, there can be no obviousness. Accordingly, in view of the foregoing reasons, withdrawal of the obviousness rejection is respectfully requested.

Double Patenting

The Action rejects claims 1, 6, 9, and 10 on the ground of nonstatutory double patenting over claims 1, 2, 8, and 9 of U.S. Patent No. 7,214,756 to Nomura et al.

Applicants respectfully request that the rejection be held in abeyance until a determination of allowable subject matter is made.

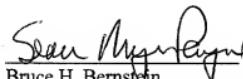
Conclusion

With the foregoing remarks, Applicants have addressed all rejections and respectfully request their withdrawal. Applicants believe that the present application is in condition for allowance.

Applicants believe that no additional fee is necessary. However, if a fee is deemed required for ensuring the pendency and consideration of this amendment, the undersigned authorizes the Office to charge Deposit Account No. 19-0089 any requisite fee.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully submitted,  
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